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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/661,177	09/12/2003	Steven Carl Crusius	5569/79287	8291
22342 7590 04/22/2009 FITCH EVEN TABIN AND FLANNERY 120 SOUTH LASALLE STREET SUITE 1600 CHICAGO, IL 60603-3406				
EXAMINER				
AMRANY, ADI				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/661,177

Applicant(s)

CRUSIUS ET AL

Examiner

ADI AMRANY

Art Unit

2836

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-8 and 10-15 is/are pending in the application.
- 4a) Of the above claim(s) 2-8 and 10-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/5508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed March 10, 2009 have been fully considered but they are not persuasive. Claim 10 has been amended to remove all limitations directed towards the battery backup apparatus, and is therefore, withdrawn as subject to a restriction by original presentation, as discussed below (MPEP §821.03). Claim 15 recites the limitations presented in previous claim drafts regarding the configuration of the battery backup apparatus. Claim 15 recites that the apparatus is "for use with a barrier movement control." The barrier movement operator is interpreted as the end use of the apparatus, as the limitation of the barrier movement operator does not breathe life into the claim. Support for this interpretation can be found below.

Claim 15 recites that the battery backup apparatus is connected to a plug on the movable barrier operator, the apparatus receives power via the plug, and the apparatus provides voltage at the plug when mains voltage to the movable barrier operator fails. These limitations are directed towards the connection to a plug and the availability of mains input voltage. The limitation of a movable barrier operator is not critical to the operation of the battery backup apparatus. The battery backup apparatus could be connected to any other electrical device and function in the same way.

Thus, Claim 15 is drawn to an independent and distinct invention from claims 2-8 and 10-14. Claim 15 is directed towards a battery backup apparatus, which was treated on the merits in previous office actions.

Election/Restrictions

2. Amended claims 2-8 and 10-11 and new claims 12-14 are directed to an invention that is independent and distinct from the invention originally claimed for the following reasons. Invention I (corresponding to claims 2-8 and 10-14, and shown in the left-side of figure 1) is drawn to a movable barrier operator system and the distribution of power within the system, comprising a mains input voltage, a DC voltage supply, and a barrier movement control coupled to the DC voltage supply via a DC power connection. Invention II (corresponding to claim 15 and the right-side of figure 1) is drawn to a battery backup apparatus configured to receive DC voltage from a DC power supply and to provide battery backup voltage when a mains input voltage fails.

3. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, Invention I has separate utility such as providing DC power from an input to a barrier movement control. Invention II has separate utility such as providing a backup battery to any electrical device (also known in the art as a uninterruptible power supply or UPS). See MPEP § 806.05(d).

Invention I does not require the connection to a battery to store excess power and supply backup power. Invention II does not require the connection to a movable barrier operator or that the voltage of the battery is connected to a barrier movement control.

The examiner has required restriction between subcombinations usable together. Where applicant elects a subcombination and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

Since the applicants have received an action on the merits for the originally presented invention (Invention II), this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, Invention I (claims 2-8 and 10-14) are withdrawn from consideration as being directed to a non-elected invention. See CFR 1.142(b) and MPEP §821.03.

The inventions would also be restrictable under MPEP §806.05(c)II as a subcombination not essential to the combination.

Further, MPEP §706.07(h) states that "applicants cannot file an RCE to obtain continued examination on the basis of claims that are independent and distinct from the claims previously claimed and examined as a matter of right (i.e. applicant cannot switch inventions). See 37 CFR 1.145. Any newly submitted claims that are directed to an invention that is independent and distinct from the invention previously claimed will be withdrawn from consideration and not entered. "

Claim Objections

4. Claim 15 is objected to because applicants first recite "a barrier movement operator" and then change the name of the limitation to "movable barrier operator." The names of claimed limitations must remain consistent throughout a claim.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Petkovsek (US 4,401,895) in view of Peplinski (US 2003/0063715).

Petkovsek discloses battery backup apparatus (fig 1; col. 2, lines 22-40) comprising:

a battery (18; col. 2, lines 53-68);

a battery charging circuit coupled to the battery (16);

wherein the battery backup apparatus is connected to a plug on an electrical device (nodes connecting the vertical conductors of the UPS to the horizontal conductors of the electrical device) and wherein the battery charging circuit is configured to receive a DC voltage from a DC power supply (12) located within the electrical device via the plug, and to charge the battery when DC voltage from the DC voltage supply exceeds a predetermined voltage (obvious);

wherein the battery backup apparatus is further configured to provide a battery backup voltage at the plug (via 20; col. 3, lines 9-20), the battery backup voltage being provided from the battery when the mains voltage to the electrical device fails (definition of a UPS); and

wherein the battery backup voltage is provided to the DC voltage supply located within the electrical device via a conduction path (horizontal conductors connecting items 12-14) that is located within the electrical device, and wherein the conduction path comprises a unidirectional isolation device (12).

The Petkovsek electrical device is interpreted as the components along the horizontal conductors connecting input nodes 10a and 10b with output nodes 10c and 10d and the end use device connected to nodes 10c and 10d. The Petkovsek battery backup apparatus is interpreted as the remaining components, including the battery (18) and converters (16, 20).

Petkovsek discloses that the battery backup apparatus is connected to the normal DC power path at two nodes (not labeled in figure 1). These nodes connect the regular DC conduction path of the load to the battery backup apparatus. It would be obvious to one skilled in the art to label this connection as "a plug." Claim 15 does not recite any limitations associated with the construction or configuration of the plug that would distinguish the plug over the nodes of Petkovsek. One skilled in the art would readily understand how to separate two sets of wires, especially when the figure shows them as separate wires joined at one select point. This connection meets the broad limitation of a plug.

The claimed limitations of charging and discharging the battery define a common UPS. Petkovsek also meets the limitations associated with the conduction path comprising a unidirectional isolation device. First, the claim recites that the battery backup voltage is provided to the DC voltage supply located within the movable barrier operator via a conduction path is located within the movable barrier operator. As discussed above, the Petkovsek Dc power supply is rectifier 12 and the conduction path is the connection between converters 12 and 14. The Petkovsek conduction path is located within the electrical device, as defined above.

Second, the claim recites that the conduction path comprises a unidirectional isolation device (i.e. diode). The claim, however, does not recite where the device is located. Petkovsek discloses a rectifier (12) connected to the conduction path. One skilled in the art would recognize that if battery voltage is provided from converter (20) to the conduction path, then that voltage potential will be available at the rectifier (12). The availability of voltage is distinguished from current flow and voltage is available at all points along a conductor.

Petkovsek does not expressly disclose the rectifier (12) comprises a unidirectional isolation device or that the battery backup apparatus. Peplinski discloses a battery backup apparatus, wherein the DC voltage supply (fig 6a; item 204) comprises a unidirectional isolation device. Petkovsek and Peplinski are analogous because they are from the same field of endeavor, namely battery backup apparatus. At the time of the invention by applicants, it would have been obvious to combine the rectifier

disclosed in Petkovsek with the rectifier disclosed in Peplinski, since it is well known in the art to use diodes to convert AC input voltage to DC voltage.

It is also noted that Peplinski discloses that a battery backup apparatus can be "for use" with a movable barrier operator, although this limitation is not given patentable weight in the art rejection of the claim, as discussed above.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ADI AMRANY whose telephone number is (571)272-0415. The examiner can normally be reached on Mon-Thurs, from 10am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Elms can be reached on (571) 272-2800 x36. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AA
4-20-09

/Stephen W Jackson/
Primary Examiner, Art Unit 2836